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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 09/599,602 Confirmation No.: 1459  
Applicant : Robert J. Rosko  
Filed : June 23, 2000  
Title : System and Method for Implementing a Consolidated Application Process  
TC/Art Unit : 3624  
Examiner: Geoffrey R. Akers  
  
Docket No. : 47004.000073  
Customer No. : 21967

MAIL STOP Appeal Brief - Patent  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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**REQUEST TO REINSTATE APPEAL**  
**TO THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Sir:

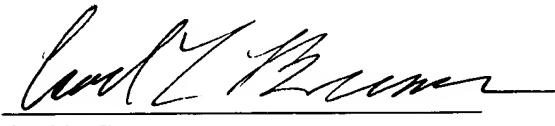
This paper is responsive to the Office action mailed January 27, 2004. The Office action was issued in response to applicant's Appeal Brief filed November 10, 2003. The Office action reopened prosecution of this application. Under 37 C.F.R. § 1.193(b)(2)(ii), applicant requests reinstatement of the appeal. A supplemental appeal brief accompanies this request.

In the event any fees are due with this request, please charge any such fees to the undersigned's Deposit Account No. 50-0206.

Dated: April 20, 2004

Respectfully submitted,  
HUNTON & WILLIAMS LLP

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SUPPLEMENTAL APPEAL BRIEF

Sir:

In accordance with 37 C.F.R. § 1.192, appellant submits this appeal brief in the above captioned application. Appellant appeals the rejection of claims 1-19 set forth in the Office action mailed January 27, 2003 (hereinafter Office action). A Notice of Appeal was filed in accordance with 37 C.F.R. § 1.191 on October 2, 2003. An initial Appeal Brief was filed November 10, 2003. An Office action reopening prosecution was mailed January 27, 2004. This submission accompanies a request under 37 C.F.R. § 1.193 to reinstate the appeal. Appellant is unaware of any fees due with the Request for Reinstatement or this Supplemental Appeal Brief. Any fees that may be due may be charged to Deposit Account No. 50-0206.

This Supplemental Appeal Brief fully complies with the requirement of 37 C.F.R. § 1.192. Accordingly, this Supplemental Appeal Brief repeats much of the information set forth in the initial Appeal Brief, while fully responding to the rejections set forth in the recent Office action. The initial Appeal Brief is hereby incorporated by reference to the extent that any relevant material is omitted from this supplemental brief.

Real Party in Interest

The real party in interest is Bank One Corporation having a place of business at Bank One Plaza, Chicago, Illinois.

Related Appeals and Interferences

Appellant appealed the rejection of claims 1-19 presented in the final Office action mailed July 2, 2003. The Examiner issued the recent Office action reopening prosecution in response to appellant's Appeal Brief filed November 10, 2003. Appellant requests that the appeal be reinstated. This Supplemental Appeal Brief fully addresses the rejections of claims 1-19 presented in the recent Office action.

To the best of appellant's knowledge, there are no related appeals or interferences.

Status of Claims

Claims 1-19 are pending and stand rejected. The rejections of claims 1-19 are appealed.

Status of Amendments

No amendments to the claims have been entered or proposed subsequent to the final rejection. No amendments to the claims are proposed in response to the recent Office action.

Summary of Invention

The present invention provides a consolidated application system that comprises a dynamic application module. Users choose one or more services provided through a networked service provider. Then, the dynamic application module presents the customer with a consolidated application, which is partially completed with information that is known about the customer. After the customer completes the blank portions of the application, the dynamic application module sends the application to another server for real-time processing.

Appellant's invention, as defined by the pending claims, is a method or system for providing a dynamically created application form through a network to a consumer applicant for one or more products. The invention is directed particularly to tailoring an application form to a

particular request from an applicant. Thus, an applicant may apply for multiple requested products, such as banking products, by completing one application form tailored to the applicant's request. As an example, a potential applicant may choose from an array of products offered by a product provider, such as a bank. The potential applicant may request to apply for a checking account and a credit card account. The instant invention then dynamically creates an application form to solicit the information required to apply for both a checking account and a credit card. In this manner, the applicant provides the required information to the bank in one convenient action.

### Issues

The issue on appeal is generally whether the teaching of the applied references is properly combined to render obvious the pending claims. Specifically, the issue is whether claims 1-19 are patentable over U.S. Patent 6,438,594 in view of U.S. Patent 6,298,356 in view of U.S. Patent 6,493,677 and further in view of U.S. Patent 6,202,054 as applied under 35 U.S.C § 103(a) in the recent Office action.

### Grouping of Claims

The combination of references applied in the recent Office action does not show or suggest most of the specific limitations set forth in the pending claims. Accordingly, although an analysis of individual claims should contain many similarities, the individual claims include limitations absent from the applied art that differentiate the claims from each other. Claims 1, 8 and 14 are independent claims. Claims 2-7 depend from claim 1. Each of claims 2-7 set forth additional limitations that are not suggested by the applied art. Accordingly, each of claims 2-7 stands on its own with respect to claim 1. Claim 8 is an independent claim with limitations, absent from the applied art, that differentiate claim 8 from claim 1. Claims 9-13 depend from claim 8. Claims 9 and 12 set forth additional limitations that are not suggested by the applied art. For the purposes of this appeal, claims 10 and 11 stand or fall with claim 9. For the purposes of this appeal, claim 13 stands or falls with claim 8. Claim 14 is similar to claim 1 and includes additional limitations related to the limitations set forth in dependent claim 7. Accordingly, for the purposes of this appeal, claims 7 and 14 stand or fall together. Claims 2-6 are identical to claims 15-19 with exception that claims 15-19 depend from claim 14 rather than claim 1.

Accordingly, should the rejection of claim 14 be upheld, claims 15-19 will stand or fall for reasons similar to claims 2-6 respectively.

## Argument

### Brief History of the Prosecution of the Application

This application was filed June 23, 2000. A preliminary amendment was filed December 19, 2000. An initial Office action was mailed August 27, 2002, in which the claims were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,438,594 issued to Michel K. Bowman-Amuah (Bowman-Amuah) in view of U.S. Patent 6,298,356 issued to Janardhanan Jawhar and Venkatachari Dilip (Jawahar). On November 27, 2002, appellant filed a response setting forth reasons why these applied references are insufficient to render the pending claims obvious. The claims were not amended. A second non-final Office action was mailed January 31, 2003, in which deficiencies of Bowman-Amuah and Jawahar were recognized. The 2003 non-final Office action rejected the claims under 35 U.S.C. § 103(a) as being unpatentable over Bowman-Amuah in view of Jawahar in view of U.S. Patent 6,493,677 issued to Ernest J. A. von Rosen and Vaclav Vincalek (von Rosen) and further in view of U.S. Patent 6,202,054 issued to Mathew P. Lawlor and Timothy E Carnody (Lawlor). On April 30, 2003, appellant filed a response setting forth reasons why these four references are insufficient to render the pending claims obvious. Again the claims were not amended. A final Office action was then mailed on July 2, 2003.

The final Office action rejected the claims for identical reasons to those presented in the initial Office action. The final Office action included an initial three paragraphs that referred to appellant's April 2003 response. The following 14 numbered paragraphs under the heading "Claim Rejections - 35 USC § 103" were practically word for word identical to the initial Office action. A brief paragraph under the heading "Response to Arguments" asserts that appellant's arguments filed in April 2003 have been fully considered. This paragraph also referred to von Rosen, which was not applied in the rejections.

Appellant's representative and the Examiner held a telephonic conversation August 11, 2003. In that conversation the Examiner confirmed that he had returned to a rejection based on only the Bowman-Amuah and Jawahar references and stated that the reference to von Rosen in

the Response to Arguments is not a part of the outstanding rejection. Appellant appreciates the Examiner's helpful suggestions regarding possible amendments to the claims. However, as the rejections in the final Office action failed to establish a *prima facie* case of obviousness against the pending claims, appellant felt compelled to appeal the final rejection over Bowman-Amuah and Jawahar.

Appellant filed an Appeal Brief on November 10, 2003, which set forth in detail the reasons, first presented in the November 2002 response, why Bowman-Amuah in view of Jawahar fails to render claims 1-19 obvious. The Examiner responded with an Office action mailed January 27, 2004. The first three paragraphs of the Office action acknowledge the Appeal Brief, reopen prosecution, and acknowledge that claim 1-19 are pending. Paragraphs 4-17 under the heading "Claim Rejection - 35 USC § 103" are word for word identical to the rejections set forth in the second Office action. Paragraph 18 of the Office action asserts, "applicant's arguments with respect to claims 1-19 have been considered but are not persuasive." It not clear what arguments the Examiner has considered. With regard to the arguments set forth in the Appeal Brief, the Examiner was persuaded to withdraw the final rejection. With regard to the arguments presented in response to the second Office action, none of the errors in the rejections noted by the appellant have been addressed or corrected

#### Requirements for Patentability

The recent Office action fails to establish a *prima facie* case of obviousness that the pending claims are unpatentable over Bowman-Amuah in view of Jawahar, von Rosen and Lawlor. "During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability." *In re Glaug*, 283 F.3d 1135, 62 U.S.P.Q.2d 1151, 1152 (Fed. Cir. 2002). "If the PTO fails to meet this burden, then the applicant is entitled to the patent." *Id.* "To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int. 1985). The references applied in the Office action fail to suggest the claimed invention for at least the reasons set forth with regard to each claim below. An artisan of ordinary skill would not have found the claimed invention to have been obvious in

light of the teaching of the applied references. As the Examiner has not presented a *prima facie* case of unpatentability, appellant is entitled to a patent.

“The ‘prima facie case’ notion . . . seemingly was intended to leave no doubt among examiners that they must state clearly and specifically any objections (the prima facie case) to patentability, and give the applicant fair opportunity to meet those objections with evidence and argument.” *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1447 (Fed. Cir. 1992)(Plager, J., concurring). The Office action makes no attempt to explain the relevance of any teachings of the applied references with regard to the claimed invention. Rather, the rejection merely states that the references teach certain elements of the claimed invention and supports these statements with citations to the applied references. “The pertinence of each reference, if not apparent, must be clearly explained.” 37 C.F.R. § 1.104(c)(2). The mere citations to the applied references do not present a convincing line of reasoning as to why an artisan would have found the claimed invention to have been obvious in light of the teachings of the applied references. This is particularly true in view of appellant’s April 2003 response, which fully sets forth why these citations are insufficient to support a rejection under 35 U.S.C. § 103(a).

A proper rejection under 35 U.S.C. § 103(a) should set for the following:

- (A) the relevant teaching of the prior art relied upon . . . ,
- (B) the difference or differences in the claim over the applied reference(s),
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

M.P.E.P. § 706.02(j). The Office action mischaracterizes the teaching of the prior art relied upon. The Office action fails to propose how the primary reference could be modified according the teaching of the secondary references to arrive at the claimed subject matter. The explanations why one of ordinary skill in the art would have been motivated to combine the references are insufficient to establish a *prima facie* case of obviousness.

The Office “can satisfy [the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness] only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598

(Fed. Cir. 1988). The motivations for combining references provided in the Office action are insufficient.

[A]n examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensorics, Inc. v. Aerasonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

*In re Rouffet*, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). In the Office action, the Examiner merely asserts the advantages of individual features selected from the applied references. No motivation for selecting the particular elements in manner suggested by the Examiner is set forth. No motivation for combining the selected elements as suggested by the Examiner is set forth. There is no support in the prior art for the proposition that the skilled artisan would have selected and combined the teachings relied upon by the Examiner to solve any problem.

"Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." M.P.E.P. § 707.07(f) (8<sup>th</sup> Ed. 2001). As appellant has traversed the outstanding rejections in the April 2003 response by showing that the applied references do not show or suggest specific limitations of the claimed invention, the Examiner should answer the substance of appellant's argument. This Office action is the fourth communication asserting that the primary reference to Bowman-Amuah teaches a method of creating an application form. Each Office action supports this assertion with a bare reference to Figures 3 and 7 of Bowman-Amuah. Although appellant has

repeatedly explained why these figures are unrelated to the creation of application forms, the Examiner has yet to provide any explanation of how Figures 3 and 7 show a method of creating an application form. The Examiner has simply alternated between mailing the initial Office action and the second Office action without addressing appellant's arguments. Accordingly, the outstanding rejection over Bowman-Amuah in view of Jawahar, von Rosen and Lawlor is improper.

Appellant herein reiterates the reasons why the applied references to Bowman-Amuah, Jawahar, von Rosen and Lawlor fail to show or suggest the claimed invention. Appellant sets forth in further detail below specific reasons why the recent Office action fails to establish a *prima facie* case of obviousness for each pending claim.

#### Applicability of the Applied References

Bowman-Amuah is directed to a system and method for delivering a plurality of services through a global computer network by use of globally addressable interfaces and locally addressable interfaces. Bowman-Amuah, col. 2, ll. 19-25. Great detail is included regarding the advantages of and methods for constructing component or object based large-scale Internet solutions for providing business services. Bowman-Amuah, cols. 10-16. However, Bowman-Amuah merely provides options and components for developing flexible computing solutions for providing any business service. Bowman-Amuah does not address the details for providing any particular service. Bowman-Amuah attempts to teach how to develop a component based Internet type business solution, rather than teaching a system or method that provides a particular service, such as accepting applications for banking products.

Jawahar is directed to methods and apparatus for enabling dynamic resource collaboration. Jawahar, col. 2, ll. 7-14. The Jawahar system provides information to a provider of web pages regarding those who access the web pages. Jawahar, col. 13, ll. 54-60. Jawahar, like Bowman-Amuah, does not address the specifics of providing any particular service through web pages. In the Jawahar system, a record of web pages viewed by a particular user is stored for reference by an agent, who may provide additional assistance to the user. Jawahar, col. 15, l. 64 - col. 16, l. 1. Certain web pages accessed by the user may be cached to determine exactly what the user accessed. Jawahar, col. 19, ll. 47-50. One use of retaining this record of a user's access is to provide further help to the user upon request. Jawahar, col. 17, ll. 33-38. Thus when

appropriate, a help button may be provided to user. Jawahar, col. 15, ll. 51-55. If the user requires further assistance, upon clicking the help button, the agent may be provided with the record of information accessed by the user. Jawahar, col. 17, ll. 47-52. The agent may then provide further assistance. Jawahar, col. 17, ll. 52-55. Accordingly, when the help button is selected, the system determines the types of web pages that have been viewed by the user and time spent viewing each type of page. Jawahar, col. 17, ll. 36-44. The system further determines the product or services associated with web pages viewed by the user. Jawahar col. 17, ll. 37-46.

Von Rosen is directed to providing an internet site that allows a customer to create and order customized branded merchandise, such as bottles of soda. Von Rosen describes displaying only one order page upon selecting an order menu item. Von Rosen, col. 9, ll. 37-41. The order page is not altered based on the type of product the user desires. There is no suggestion to assemble the order page from multiple documents related to different types of products. In fact, the von Rosen system gathers the same information for each and every transaction. Von Rosen, col. 9, l. 41 - col. 10, l. 18. The order taking process is identical regardless of what type of products the user desires to order. Von Rosen, col. 11, l. 62 - col. 12, l. 54, figs. 13A - 13B.

Lawlor is directed to a system for providing electronic home banking and bill-paying services through ATM networks. The Lawlor system provides dedicated telephone-based banking terminals to users for home banking use. Lawlor, col. 6, ll. 59-61. The terminal is designed to interact with users in a manner similar to ATM user interaction. Lawlor, col. 8, ll. 1-2. Lawlor is silent regarding the application process for banking products and services and provides no application for requesting information to apply for multiple products or services.

Appellant's invention, as defined by the pending claims, is a method or system for providing a dynamically created application form through a network to a consumer applicant for one or more products. (Spec. p. 1, ll. 5-7.) The invention is directed particularly to tailoring an application form to a particular request from an applicant. (Spec. p. 3, ll. 7-10.) Thus an applicant may apply for multiple requested products, such as banking products, by completing a single application form tailored to the applicant's request. (Spec. p. 8, l. 21 - p. 9, l. 2.) As an example, a potential applicant may chose from an array of products offered by a product provider, such as a bank. (Spec. p. 8, ll. 2-4.) The potential applicant may request to apply for a checking account and a credit card account. (Spec. p. 8, ll. 20-21.) The instant invention then dynamically creates an application form to solicit the information required to apply for both a

checking account and a credit card. (Spec. p. 10, ll. 1-4.) In this manner, the applicant provides the required information to the bank in one convenient action.

“In order to rely on a reference as the basis for rejection of an applicant’s invention, the reference must be either in the field of applicants endeavor or, if not, then reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992). Appellant’s invention relates to allowing customers of a networked service provider to apply for a variety of networked services on one dynamically assembled consolidated application and enables them to receive real time decisioning on their application status for many products. (Spec. p. 1, ll. 5-8.) The field of appellant’s invention is thus related to electronic commerce with emphasis on the finance and banking industries. Bowman-Amuah is related to software patterns, particularly to aiding a system in need of service by locating a service provider capable of delivering the required service by way of a locally addressable interface. (Bowman-Amuah, col. 1, ll. 18-22.) Bowman-Amuah is thus in the field of network management and access regulation during multiple computer data transfer and process coordination. One of ordinary skill looking to allow customers of a service provider apply for a variety of networked services on one dynamically assembled consolidated application would have no reason to look to the field of network management and access regulation during multiple computer data transfer and process coordination. One of ordinary skill in the art to which the claimed invention pertains would not have been aware of the teachings of Bowman-Amuah. Accordingly, Bowman-Amuah cannot properly be relied upon as the basis for rejection of appellant’s invention. Appellant respectfully requests that the rejections of claims 1-19 be reversed for at least this reason.

The applied references fail to show or suggest any system or method for applying for any product. The applied art to Bowman-Amuah and Jawahar rather is directed either to the features of Internet or Web based systems with broad application to various tasks. The applied art to von Rosen is directed to a web based ordering system for customized merchandise. The applied art to Lawlor is directed to non-web based home banking system. None of the applied art addresses receiving applications (forms used in making a request) from potential customers for selected products. Accordingly, the applied prior art fails to suggest the specific details of appellant’s invention as set forth in the pending claims. The details of the features absent from the applied art are discussed further below.

Claim 1

Claim 1 sets forth a method for dynamically creating an application form. The method includes steps of receiving a request to apply for a plurality of products, assembling an application page from a plurality of documents each of which contains a field corresponding to specific information required to apply for a product, and receiving information corresponding to each field in the application page. The instant specification describes a particular preferred embodiment of the claimed invention. In this embodiment, an Internet banking services provider receives a potential customer's request to apply for products such as a checking account and a credit card account offered by the provider. An application page is assembled and provided to the customer. The application page requests only information required to apply for both the checking account and the credit card. The customer may then complete the application through the application page provided and cause the completed application to be sent to the provider. The applied combination of references fails to show or suggest the steps set forth in claim 1.

In the Office action in paragraph 6, it is asserted that Bowman-Amuah teaches a method for dynamically creating a network application form. This assertion is incorrect. The support provided for this assertion is a citation to Figures 3 and 7 of Bowman-Amuah. Bowman-Amuah is mischaracterized in the Office action. These figures do not teach dynamically creating a network application form. In the instant specification on page 4 it is stated: "That the system is described as being part of an Internet system that enables customers of an Internet banking service provider to complete applications of particular banking services, where the applications are pre-filled with customer's personal information." The term "application form" is thus used in the sense of a form that is completed with information to apply for particular products or services. This is confirmed by the use of the term "application form" in the last line of page 10 of the instant specification.

Bowman-Amuah is silent regarding creation of an application form. Bowman-Amuah extols the virtues of using the principles of architecture in building computer software. Bowman-Amuah, col. 17 ll. 20-23. An advantage of using architecture principles is "there is something repeatable about the work: architects can create a structure, then use the components of that structure again in the future when they come across a similar situation." Bowman-Amuah, col. 17, ll. 28-31. The advantage is that the underlying structure of the computer

software is not directly related to the specific tasks to be performed. Accordingly, Bowman-Amuah refers to Technology Architecture (the underlying structure) and Application Architecture (task specific structure). *See* Bowman-Amuah, col. 24 ll. 1-5. Bowman-Amuah thus uses the term “application” to refer to task specific computer software. Figure 3 of Bowman-Amuah illustrates a standard architecture framework. In Figure 3, various underlying structures support the applications. Figure 3 includes no teaching specific to application forms. Figure 3 provides no support for the assertion that Bowman-Amuah teaches a method of creating an application form.

Bowman-Amuah classifies technology architecture structures by technology era. Bowman-Amuah, col. 24 ll. 8-13. Columns 25-32 of Bowman-Amuah include a section titled “Technology Generation Selection,” which sets forth the strengths and weaknesses of each technology generation. Bowman-Amuah, col. 25, ll. 58-65. Figure 7 is directed to the situation in which the Netcentric technology generation should be considered. Bowman-Amuah, col. 27, ll. 7-10. Figure 7 provides no teaching specific to application forms. Figure 7 provides no support for the assertion that Bowman-Amuah teaches a method of creating an application form.

Neither Figure 3 nor Figure 7 of Bowman-Amuah show or suggest a method for dynamically creating a network based application form. The reliance on these figures in the Office action is misplaced.

The applied art fails to show or suggest a step of receiving a request to apply for a plurality of products. In paragraph 6 of the Office action, Figure 9 of Bowman-Amuah is relied upon to suggest this step. Figure 9 is part of the “Technology Generation Selection” section of Bowman-Amuah and is directed to the situation in which the Host technology generation should be considered. Bowman-Amuah, col. 30, ll. 24-31. The Office action refers specifically to element 902. Element 902 is the business imperatives indicating the use of the Host technology generation. Bowman-Amuah, col. 30, l. 47. None of the business imperatives shown in Figure 9 are directly related to receiving a request to apply for a plurality of products. Appellant’s invention relates to a particular consumer application for particular products provided by a business. Bowman-Amuah simply does not address a method for applying for products and thus fails to suggest a step of receiving a request to apply for a plurality of products as set forth in claim 1. Claim 1 is expressly applicable to the situation in which information is required to be submitted to apply for each one of the plurality of products. Bowman-Amuah fails to show or

suggest any particular computer system that receives applications from consumers for products, such as applications for banking products. Bowman-Amuah fails to address any situation wherein specific information is required to be submitted to apply for each one of a plurality of products. The bare citation to Figure 9 and element 902 of Bowman-Amuah fails demonstrate that the prior art teaches a step of receiving a request to apply for a plurality of products.

The applied art fails to show or suggest a step of assembling an application page for display over a network. In the Office action, it is acknowledged that Bowman-Amuah does not teach this step. Von Rosen is relied upon to show this step. The Office action states “Von Rosen teaches assembling an application page for display over a network for products or services(Fig 2)(Abstract)(Fig 8A)(Fig 8B) assembled from a plurality of documents.” Although appellant has set forth in detail why the cited portions of von Rosen do not show or suggest this step, no explanation is provided in the Office action regarding how the abstract and the cited figures suggest this step. Figure 2 of von Rosen illustrates the components of the system for ordering customized branded merchandise over a computer network. There is no explanation in the Office action setting forth the relevance of Figure 2 to the step of assembling an application page. Figure 2 does not show or suggest assembling an application page. The abstract of von Rosen is directed to one method and apparatus for creating and ordering customized branded merchandise over a computer network. The abstract does not suggest assembling an application page assembled from a plurality of documents. Figures 8A and 8B illustrate windows produced by a WWW browser installed on a client computer browsing a WWW site embodying aspects of the von Rosen system. Von Rosen states: “If the consumer selects the order menu item 180 from the menu 168, an order WWW page 178 will be displayed on WWW browser 118 as shown in FIGS. 8A and 8B.” Von Rosen, col. 9, ll. 37-39. Von Rosen does not suggest that the order page 178 is assembled from a plurality of documents. Furthermore, as apparently acknowledged in the Office action, von Rosen suggests no documents that contain fields corresponding to the specific information required to apply for one of the plurality of products as set forth by claim 1. Von Rosen fails to show or suggest assembling an application page for display over a network, where the page is assembled from a plurality of documents as set forth by claim 1.

The Examiner fails to propose a modification of Bowman-Amuah based on the teaching of von Rosen necessary to arrive at the claimed subject matter. There is no explanation in the Office action regarding how any application page allegedly taught by von Rosen could be

combined with the Bowman-Amuah system and method for delivering a plurality of services through a global computer network by use of globally addressable interfaces and locally addressable interfaces. There is no explanation how the Bowman-Amuah system could be modified using any teaching from von Rosen. There is no suggestion that any specific page suggested by von Rosen would have any applicability in the Bowman-Amuah system.

There is no motivation to combine the teachings of von Rosen and Bowman-Amuah as suggested in the Office action. The Office action, in paragraph 6, states “The motivation to combine is to teach an apparatus for creating and ordering merchandise over a network as enunciated by von Rosen(col 1 line 64-col 2 line 12) at a website.” This statement is merely a motivation to develop the von Rosen system, as von Rosen itself is directed to providing a method and apparatus for creating and ordering merchandise over a computer network. The Office action fails to state a motivation to then combine the teaching of von Rosen into the system of Bowman-Amuah. There is no suggestion in the applied art to combine the apparatus for creating and ordering merchandise of von Rosen with a system for delivering a plurality of services by using globally addressable interfaces and locally addressable interfaces such as the Bowman-Amuah system.

Claim 1 further sets forth that the application page is assembled from documents, wherein each document contains at least one field corresponding to information required to apply for a product. In the Office action it is apparently recognized that neither Bowman-Amuah nor von Rosen show or suggest this limitation. Jawahar is applied to show this limitation. The Office action states “Jawahar teaches whereby each document contains at least one field in the document containing one field related to information required to make an application (Fig 3/118/94/92/90/114/116/120)(Fig 5)(Fig 6)((Fig 8)(Fig 9/274)(Fig 10).” Although appellant, in the response to the second Office action, has provided a full explanation as to why the cited material fails to suggest this claim limitation, no support for the Examiner’s statement is provided in the Office action. Jawahar does not show or suggest a plurality of documents wherein each document contains at least one field corresponding to the specific information required to apply for one of the plurality of products. None of the figures cited in the Office action suggest any field associated with applying for any product. As discussed above, the contents of the web pages viewed by the user (specifically with regard to any product or services presented) is recorded by the Jawahar system. However, no documents are suggested that

contain any field corresponding to specific information required to apply for any of the presented products.

Figure 3 of Jawahar illustrates a control server including video transaction manager 118, video server 94, fax server 92, e-mail server 80, e-mail transaction manager 114, fax transaction manager 116, and transaction processing system manager 120. Figure 5 is a flow diagram illustrating a procedure for communicating information between various devices. Figure 6 illustrates various windows displayed to an agent using the agent's computer. Figure 8 is a flow diagram illustrating a procedure for determining whether to display a "Help" button to a user. Figure 9 is a flow diagram illustrating a procedure for selecting an agent to provide help to a user. Figure 9 includes step 274 for determining product(s) or service(s) associated with the web pages viewed by the user. Figure 10 illustrates a table containing information relating to web pages accessed by a user. The Office action includes no explanation how any of these figures would suggest to one of ordinary skill a plurality of documents wherein each document contains at least one field corresponding to specific information required to apply for one of a plurality of products. To the contrary, Figures 9 and 10 demonstrates that each page of the Jawahar system describes aspects of a single product. There is no suggestion that any of these pages includes a field corresponding to information required to apply for a product. Accordingly, Jawahar does not teach a plurality of documents, each with a field corresponding to information required to apply for a product as set forth by claim 1.

The Examiner fails to propose a modification of Bowman-Amuah in view of von Rosen based on the teaching of Jawahar necessary to arrive at the claimed subject matter. There is no explanation in the Office action regarding how any document allegedly taught by Jawahar could be combined with the Bowman-Amuah system and method for delivering a plurality of services through a global computer network by use of globally addressable interfaces and locally addressable interfaces. There is no explanation how the Bowman-Amuah system could be modified using any teaching from Jawahar. There is no suggestion that any specific page suggested by Jawahar would have any applicability in the Bowman-Amuah system. Furthermore, the Examiner apparently is asserting that one skilled in the art would assemble an application page, allegedly taught by von Rosen, from a plurality of documents, allegedly taught by Jawahar. The Office action includes no explanation how the order page of von Rosen could be modified using any pages from the Jawahar system or the data regarding products or services

collected by the Jawahar system. There is no suggestion to include multiple pages directed to different products in von Rosen. Even should one modify the von Rosen system to include multiple order pages directed to different products, there is no suggestion how such pages would use the information collected by the Jawahar system.

There is no motivation to combine the teachings of Jawahar and Bowman-Amuah as suggested in the Office action. The Office action, in paragraph 6, states “The motivation to combine is to teach the search of static and dynamically generated web pages having information on them with respect to products or services (col 16 lines 59-63) being accessed by a web server with respect to information gathered and resources spent on the search of these pages as enunciated by Jawahar (col 1 line 59-col 2 line 4).” First, neither Jawahar nor the other applied references teach the search of static and dynamically generated web pages. In the Jawahar system, non-displayable information embedded in tagged web pages is logged. Jawahar col. 14, l. 56 - col. 15, l. 15. Second, a skilled artisan would have no motivation to use any of the information logged by the Jawahar system in the systems of Bowman-Amuah or von Rosen. That Jawahar teaches gathering information on viewed web pages is not itself motivation to use such information in the systems of Bowman-Amuah or von Rosen.

The applied art also does not suggest the step of receiving information input corresponding to each field contained in the application page as set forth by claim 1. In paragraph 6 of the Office action, the Summary of the Invention of Jawahar is relied upon to show this step of receiving. The Office asserts that Jawahar teaches, “receiving information input corresponding to each field contained in each application page (col 2 lines 6-59).” However, the Summary in Jawahar includes no suggestion of receiving any information required to apply for any product. The summary merely addresses receiving requests to view web pages from a user. Jawahar, col. 2, ll. 11-13. Jawahar includes no suggestion that these requests include any information input that corresponds to fields of an application page as set forth by claim 1.

Appellant notes that the rejections of claims 1, 8 and 14 are set forth in paragraph 6 of the Office action. Although the remaining applied reference to Lawlor is discussed in paragraph 6, Lawlor is not applied to teach any limitation of claim 1.

For at least the above reasons, Bowman-Amuah in view of Jawahar, von Rosen and Lawlor does not show or suggest the invention defined by claim 1. The bare citations to the applied references fail to present a convincing line of reasoning as to why an artisan would have

found the claimed invention to have been obvious. The Office action fails to clearly explain the pertinence of each reference. None of the applied references are directed to applying for products, such as banking products. The applied references taken in any combination fail to show or suggest steps of receiving a request to apply for a plurality of products, assembling an application page, or receiving information corresponding to the application page. Accordingly, the Office action does not establish a *prima facie* case of obviousness against claim 1. Appellant, therefore, respectfully requests that this rejection of claim 1 be reversed.

### Claim 2

Claim 2 depends from claim 1 and therefore includes each step of the method of claim 1. The rejection of claim 2 is deficient for the reasons set forth above with respect to claim 1. Further significant defects of the applied references as applied to claim 2 are discussed below.

Claim 2 further sets forth validating the information input, if the validation is not correct a second application page is assembled including prompts to reenter information. The secondary reference to Jawahar is relied upon to show the steps set forth in claim 2 as it is acknowledged in the Office action that the primary reference does not teach data validation. The Office action in paragraph 7 states that Jawahar teaches data validation and dynamically generated pages containing critical information. This statement is insufficient to demonstrate that Jawahar suggests the additional steps of claim 2. First, the mere explanation of dynamically generated pages in Jawahar is insufficient to teach the details of the presently claimed invention. The present invention includes assembling *an application page* and validating information input received that corresponds to the fields of the application page. Jawahar fails to suggest dynamic web pages that include fields corresponding to information needed *to apply* for more than one product. Second, although various citations to Jawahar are provided in the Office action, none of the cited passages address validation as set forth in claim 2. Column 18, line 28, through column 19, line 2, of Jawahar is directed to introducing dynamic web pages and the disadvantages of URL sharing. Column 6, lines 40-58, is directed to the features of an agent computer system. Column 13, lines 29-31, states that the window displayed to the agent contains various system information such as information about the agent and about system performance. Column 20, lines 34-44, indicates that web pages including an expiration date may be dynamic web pages, which should be cached. There is no suggestion in any of these citations of a validation by

comparing information. There is no suggestion in any of these citations of assembling a second application page. Jawahar does not suggest comparing data received to validation criteria and assembling a second application page if the validation is not correct as set forth in claim 2. Furthermore, there is no motivation to combine the teachings of Bowman-Amuah and Jawahar for the reasons discussed above with respect to claim 1.

For at least the reasons set forth with respect to claim 1 and the further specific reasons set forth above, Bowman-Amuah in view of Jawahar, von Rosen and Lawlor does not show or suggest the steps of the invention defined by dependent claim 2. Accordingly, the Office action does not establish a *prima facie* case of obviousness against claim 2. Appellant respectfully requests that the rejection of claim 2 over Bowman-Amuah in view of Jawahar, von Rosen and Lawlor be reversed.

### Claim 3

Claim 3 depends from claim 1 and therefore includes each step of the method of claim 1. The rejection of claim 3 is deficient for the reasons set forth above with respect to claim 1. Further significant defects of the applied references as applied to claim 3 are discussed below.

Claim 3 includes the step of forwarding the information input to a decision module for processing the information input. In paragraph 8 of the Office action, it is acknowledged that Bowman-Amuah does not teach this step. The Office action asserts “Lawlor teaches this(Fig 1A/80/80D).” Figure 1A of Lawlor is a block diagram of a CPU in a financial distribution system. Figure 1A illustrates that the CPU 80 includes an authorization module 80D. The authorization module is the means by which the system determines the customer’s identity (through the PIN and other values transmitted by the terminal). Lawlor, col. 19, ll. 39-41. The information input as set forth in claim 1 corresponds to each field contained in the application page. Lawlor does not suggest that the system is used to apply for products. No information input corresponding to an application page is received by the CPU 80 of Lawlor. Rather, the authorization module 80D of Lawlor merely clears a user for transactions regarding existing accounts.

The Examiner fails to propose a modification of Bowman-Amuah in view of Jawahar and von Rosen based on the teaching of Lawlor necessary to arrive at the claimed subject matter. The Office action includes no explanation how the authorization module of Lawlor could be used

in the Bowman-Amuah system and method for delivering a plurality of services or with the systems of Jawahar or von Rosen. The Examiner has selectively chosen features from the applied art, but has failed to explain how they could be combined to arrive at the claimed subject matter.

There is no motivation found in the prior art to combine these references. In paragraph 8 of the Office action it is asserted “The motivation to combine is to teach an apparatus for delivering banking and other financial services to customer homes and offices over a network as enunciated by Lawlor.” This is merely the motivation to develop the Lawlor system. No motivation is provided to combine any element of the Lawlor system with the teachings of Bowman-Amuah, von Rosen and Jawahar. In fact, Lawlor specifically teaches away from any combination with the personal computer based systems of Jawahar and von Rosen. Lawlor specifically provides an ATM based system that does not use a personal computer. Lawlor col. 2, ll. 47-50, col. 6, ll. 32-41. Lawlor specifically teaches away from the use of personal computers to deliver banking services and thus teaches away from any combination with the Jawahar and von Rosen systems.

For at least the reasons set forth with respect to claim 1 and the further specific reasons set forth above, Bowman-Amuah in view of Jawahar, von Rosen and Lawlor does not show or suggest the steps of the invention defined by dependent claim 3. Accordingly, the Office action does not establish a *prima facie* case of obviousness against claim 3. Appellant respectfully requests that the rejection of claim 3 over Bowman-Amuah in view of Jawahar, von Rosen and Lawlor be reversed.

#### Claim 4

Claim 4 depends from claim 1 and therefore includes each step of the method of claim 1. The rejection of claim 4 is deficient for the reasons set forth above with respect to claim 1. Further significant defects of the applied references as applied to claim 4 are discussed below.

Claim 4 includes the steps of determining whether the request to apply originates from a customer that is logged in to a session manager, and accessing stored data regarding the customer if the customer is logged in. The step of assembling an application page is further defined to include inserting the stored data in the application page. The steps of claim 4 permit the claimed system to use secure information regarding a customer to prefill fields in an application form for

a product when information required to apply for the product is already known to the product provider. (Spec. p. 10, ll. 14-19.)

In paragraph 9 of the Office action, it is acknowledged that Bowman-Amuah does not teach a step of determining whether the request to apply originates from a customer that is logged into a session manager. It is asserted that Jawahar teaches this. The Office action does not address the step of accessing stored data regarding a customer. The Office action does not address the limitation that the step of assembling an application page includes inserting the stored data in the application page. Accordingly, the Office action fails to establish a *prima facie* case of obviousness against claim 4.

Figures 3, 11, 13 and 14 of Jawahar are cited to support the assertion that Jawahar teaches a step of determining whether the request to apply originates from a customer that is logged into a session manager. Figure 3 of Jawahar illustrates a control server including a transaction host 102 and a transaction processing system 120. The transaction host 102 manages interaction between an agent and a customer. Jawahar col. 10, ll. 9-18. There is no suggestion that the transaction host or transaction processing system determines whether a customer is logged in or inserts stored data in an application page. Figures 11, 13, and 14 are flowcharts of the Jawahar system that illustrate that a session between a customer and an agent is established. There is no suggestion that this session includes determining whether a customer is logged in or inserting stored data in an application page. Jawahar shows that a user (first client) and agent (second client) can be connected through a joint session in which the server may duplicate what is presented to the user and the agent. Jawahar, col. 8 ll. 26-40. In this manner the agent may view the resources viewed by the user and the agent may provide resources to the user. Jawahar, col. 18, ll. 56-58. However, there is no suggestion that stored data regarding a customer is inserted in an application page for applying for products as set forth by claim 4. Furthermore, there is no suggestion to combine Bowman-Amuah and Jawahar for the reasons discussed above with respect to claim 1.

For at least the reasons set forth with respect to claim 1 and the further specific reasons set forth above, Bowman-Amuah in view of Jawahar, von Rosen and Lawlor does not show or suggest the steps of the invention defined by dependent claim 4. Accordingly, the Office action does not establish a *prima facie* case of obviousness against claim 4. Appellant respectfully

requests that the rejection of claim 4 over Bowman-Amuah in view of Jawahar, von Rosen and Lawlor be reversed.

Claim 5

Claim 5 depends from claim 1 and therefore includes each step of the method of claim 1. The rejection of claim 5 is deficient for the reasons set forth above with respect to claim 1. Further significant defects of the applied references as applied to claim 5 are discussed below.

Claim 5 sets forth that the plurality of products applied for includes banking products and the information required to apply for one of the products includes information regarding an amount of credit to be extended. In paragraph 10 of the Office action, it is acknowledged that Bowman-Amuah does not teach the limitations set forth in claim 5. It is asserted that Jawahar teaches the limitations. Column 19, lines 38-46, of Jawahar is cited to support this assertion. This passage is silent regarding applications for banking products and is silent regarding an amount of credit to be extended.

Jawahar discusses uniform resource locator (URL) sharing as a method of providing user information to an agent. As an example of where URL sharing is *inappropriate*, Jawahar mentions banking transactions. Jawahar col. 19, ll. 27-46. Jawahar describes that in online banking transactions the customer's account number and transaction request information may be embedded in the URL. If the agent in this example were to access the same URL, the agent could improperly execute the banking transaction. Jawahar notes that online banking transactions may result in a withdrawal, transfer, or deposit. Significantly, Jawahar does not discuss applying for a bank account. In the transactions noted by Jawahar, the customer has already established an account with the banking services provider and has an account number. Accordingly, Jawahar includes no suggestion of any assembly of a page to apply for the bank account or other product. More specifically, there is no suggestion in Jawahar of an application page that contains a field corresponding to information regarding an amount of credit to be extended to the customer as specifically set forth in claim 5. There is also no motivation found in the prior art to combine the teaching of Jawahar with the teaching of Bowman-Amuah for the reasons discussed above with respect to claim 1. Jawahar teaches away from combining URL sharing with banking transaction systems.

For at least the reasons set forth with respect to claim 1 and the further specific reasons set forth above, Bowman-Amuah in view of Jawahar, von Rosen and Lawlor does not show or suggest the steps of the invention defined by dependent claim 5. Accordingly, the Office action does not establish a *prima facie* case of obviousness against claim 5. Appellant respectfully requests that the rejection of claim 5 over Bowman-Amuah in view of Jawahar, von Rosen and Lawlor be reversed.

### Claim 6

Claim 6 depends from claim 5 and therefore includes each step of the method of claim 5. The rejection of claim 6 is deficient for the reasons set forth above with respect to claim 1 and 5. Further significant defects of the applied references as applied to claim 6 are discussed below.

Claim 6 further sets forth forwarding the information input to a decision module for processing to determine if data input justifies extension of credit. In paragraph 11 of the Office action, it is asserted “Lawlor teaches this(Figs 12-17).” Lawlor is directed to ATM type transactions using a home terminal. The Lawlor system is used to access bank accounts. Lawlor, col. 6, l. 59 - col. 7, l. 10. The Lawlor system does not address the process of applying for the account accessed through the ATM system. Accordingly, the Lawlor system does not processes input information to determine if the extension of credit is justified. Nothing in Figures 12-17 of Lawlor suggests that system processes information to determine if data input justifies extension of credit as set forth by claim 6. Figure 12 is a flow chart of program control steps included in the main menu routine. Lawlor, col. 39, ll. 46-48. Figure 12 depicts options to pay bills, transfer funds, access account information, and exit the session. Notably absent is any option to *apply* for any banking product. No determination if an extension of credit is justified is shown in Figure 12. If the user selects the “pay bill” option a bill process routine is executed as depicted in the flow chart of Figure 13. Lawlor, col. 40, ll. 6-8. The bill process routine includes options to pay bills, review existing bills, and exit bill paying as show in Figure 13. The review existing bills option is executed through a REVCOR routine depicted in Figure 17. Lawlor, col. 44, ll. 49-54. The pay bills option is executed through a bill pay routine depicted in Figure 14. Lawlor, col. 40, ll. 60-67. The bill pay routine calls a check date routine depicted in Figure 15. Lawlor, col. 43, ll. 18-22. The bill pay routine also calls a dates routine to calculate dates of periodic recurring payments depicted in Figure 16. Lawlor, col. 43, ll. 57-61. None of these

flow charts show an option to apply for a banking product. None of these flow charts include a step of processing information to determine if an extension of credit is justified. Furthermore, as discussed above there is no motivation found in the prior art to combine Lawlor with the other applied references for the reasons discussed above with respect to claim 3.

For at least the reasons set forth with respect to claims 1 and 5 and the further specific reasons set forth above, Bowman-Amuah in view of Jawahar, von Rosen and Lawlor does not show or suggest the steps of the invention defined by dependent claim 6. Accordingly, the Office action does not establish a *prima facie* case of obviousness against claim 6. Appellant respectfully requests that the rejection of claim 6 over Bowman-Amuah in view of Jawahar, von Rosen and Lawlor be reversed.

### Claim 7

Claim 7 depends from claim 1 and therefore includes each step of the method of claim 1. The rejection of claim 7 is deficient for the reasons set forth above with respect to claim 1. Further significant defects of the applied references as applied to claim 7 are discussed below.

Claim 7 sets forth that the request is in the form of parameters received within a universal resource locator (URL). In paragraph 12 of the Office action, it is acknowledge that Bowman-Amuah does not teach a request in the form of parameters received with a URL. Column 21, line 56 - column 22, line 3, of Jawahar is relied upon to show this limitation. Jawahar shows the use of URLs and modified URLs for requesting information from a server, as is the function of a URL. The cited passage of Jawahar is directed to modified URLs. Should a client request a resource from a host other than the session host, the URL is modified to redirect the request through the session host. Jawahar, col. 21, l. 56 - col. 22, l. 3. However, Jawahar does not suggest that any URL is a request to apply for products, as is the request set forth in claim 1. Jawahar does not show or suggest a request to apply for products in the form of parameters received within a universal resource locator as set forth in claim 7. Furthermore, there is no motivation found in the prior art to combine the teachings of Bowman-Amuah and Jawahar for the reasons discussed above with respect to claims 1.

For at least the reasons set forth with respect to claim 1 and the further specific reasons set forth above, Bowman-Amuah in view of Jawahar, von Rosen and Lawlor does not show or suggest the steps of the invention defined by dependent claim 7. Accordingly, the Office action

does not establish a *prima facie* case of obviousness against claim 7. Appellant respectfully requests that the rejection of claim 7 over Bowman-Amuah in view of Jawahar, von Rosen and Lawlor be reversed.

Claims 8 and 13

Claim 8 sets forth a system for obtaining application data from an applicant through a dynamically created application form. The claimed system includes a dynamic application module and a decision module. The dynamic application module receives requests to apply for at least one of a plurality of products, dynamically creates an application requesting data required to apply for the requested products, and receives the requested data. The decision module receives the data, generates a decision regarding the application, and provides the decision to the dynamic application module. Claim 8 is rejected on the same grounds as claim 1. The applied references do not show or suggest the system of claim 8 for reasons similar to those discussed above with respect to claim 1. Claim 8 is directed to a system for creating and processing applications for products, such as bank account or credit card accounts. The applied art of Bowman-Amuah, Jawahar, von Rosen and Lawlor fails to describe any system in which a consumer applies for any product such as a bank account or credit card. There is no suggestion or motivation to combine the teachings of the applied references for the reasons discussed above with respect to claim 1.

Claim 8 sets forth a dynamic application module. The dynamic application module is for receiving a request to apply for at least one of a plurality of products, dynamically creating an application requesting data required to apply for the at least one of a plurality of products, and receiving the data requested. The Office action does not demonstrate where such a dynamic application module is shown or suggested in the applied art. The Office action merely addresses the steps of the method of claim 1. The applied art fails to show or suggest receiving a request to apply for at least one of a plurality of products, dynamically creating an application requesting data required to apply for the at least one of a plurality of products, and receiving the data requested for the reasons set forth above with respect to claim 1. Furthermore, the applied art fails to teach any dynamic application module for implementing these operations.

Claim 8 sets forth a decision module in communication with the dynamic application module. The decision module is for receiving the data, generating a decision regarding the

application, and providing the decision to the dynamic application module. In paragraph 6 of the Office action, it is asserted that Lawlor teaches a decision module in communication with a dynamic application module. Lawlor is directed to remote delivery of banking services through a dedicated terminal. This terminal is used to pay all bills, transfer funds, obtain balance information, look forward and backward at statement activity, transfer funds among accounts and banks, and obtain information on bank services and rates. Lawlor col. 10, ll. 8-13. There is no suggestion that terminal is used to *apply* for any bank account or service. Accordingly, there is no suggestion of a module for receiving data required to apply for a product from the terminals of Lawlor. There is no suggestion in Lawlor of a module for generating any decision regarding an application. There is no suggestion in Lawlor of a module that provides a decision regarding an application to a dynamic application module.

The Office action cites to figures 17B, 13, 12 and 14-15 of Lawlor. These figures suggest neither a dynamic application module nor a decision module as set forth in claim 8. Figure 12 is a flow chart of program control steps included in the main menu routine. Lawlor, col. 39, ll. 46-48. Figure 12 depicts options to pay bills, transfer funds, access account information, and exit the session. Absent is any option to apply for any banking product. No module for dynamically creating an application and no module for generating a decision regarding an application is shown in Figure 12. If the user selects the “pay bill” option a bill process routine is executed as depicted in the flow chart of Figure 13. Lawlor, col. 40, ll. 6-8. The bill process routine includes options to pay bills, review existing bills, and exit bill paying as shown in Figure 13. The review existing bills option is executed through a REVCOR routine depicted in Figure 17. Lawlor, col. 44, ll. 49-54. Figure 17B is merely one sheet of the flow chart of the REVCOR routine. The pay bills option is executed through a bill pay routine depicted in Figure 14. Lawlor, col. 40, ll. 60-67. The bill pay routine calls a check date routine depicted in Figure 15. Lawlor, col. 43, ll. 18-22. None of the figures relied upon in Lawlor depicts a decision module in communication with a dynamic application module as asserted in the Office action.

There is no motivation found in the prior art to combine the applied references. In the Office action it is asserted: “The motivation to combine is to teach an apparatus for delivering banking and other financial services to customer homes and offices over a network as enunciated by Lawlor.” There is no suggestion that banking services of Lawlor are useful within the

systems of Bowman-Amuah, Jawahar, and von Rosen. In fact, Lawlor specifically teaches away from any combination with the personal computer based systems of Jawahar and von Rosen. Lawlor specifically provides an ATM based system that does not use a personal computer. Lawlor col. 2, ll. 47-50, col. 6, ll. 32-41. Lawlor expressly teaches away from the use of personal computers to deliver banking services and, thus, teaches away from any combination with the Jawahar and von Rosen systems.

For at least the reasons set forth above, Bowman-Amuah in view of Jawahar, von Rosen, and Lawlor does not show or suggest the components of the system defined by claim 8. Accordingly, the final Office action does not establish a *prima facie* case of obviousness against claim 8. Appellant respectfully requests that this rejection of claim 8 be reversed.

Claim 13 depends from claim 8 and therefore includes each element of the system of claim 8. The rejection of claim 13 is deficient for the reasons set forth above with respect to claim 8.

#### Claims 9 - 11

Claim 9 depends from claim 8 and therefore includes each element of the system of claim 8. The rejection of claim 9 is deficient for the reasons set forth above with respect to claim 8. Further significant defects of the applied references as applied to claim 9 are discussed below.

Claim 9 further sets forth that the system includes a universal session manager and a profile database. The universal session manager verifies the originator of the request received by the dynamic application module. The profile database provides stored data regarding the originator of the request. In paragraph 13 of the Office action, Figure 2 and column 7, lines 53-65 of Jawahar are relied upon to show these features. Jawahar describes that an application server (element 62 of Figure 2) may retrieve information about a customer from a database (element 58 of Figure 2). Jawahar, col. 7 ll. 60-62. The information is then provided to an agent application for display on an agent computer system. Jawahar, col. 7 ll. 62-64. However, Jawahar includes no suggestion that the application server, or any other server, verifies the originator of a request, as does the universal session manager set forth in claim 9. Furthermore, there is no motivation to combine Bowman-Amuah and Jawahar for the reasons discussed above with respect to claim 1.

For at least the reasons set forth with respect to claim 8 and the further specific reasons set forth above, Bowman-Amuah in view of Jawahar, von Rosen and Lawlor does not show or suggest the steps of the invention defined by dependent claim 9. Accordingly, the final Office action does not establish a *prima facie* case of obviousness against claim 9. Appellant respectfully requests that the rejection of claim 9 over Bowman-Amuah in view of Jawahar, von Rosen and Lawlor be reversed.

Claims 10 and 11 depend from claim 9 and therefore include each element of the system of claim 9. The rejection of claims 10 and 11 are deficient for the reasons set forth above with respect to claim 9. Accordingly, appellant respectfully requests that the rejection of claims 10 and 11 over Bowman-Amuah in view of Jawahar, von Rosen and Lawlor be reversed.

#### Claim 12

Claim 12 depends from claim 11 and therefore includes each element of the system of claim 11. The rejection of claim 12 is deficient for the reasons set forth above with respect to claim 11. Further significant defects of the applied references as applied to claim 12 are discussed below.

Claim 12 further sets forth that the dynamic application module provides the application in the form of an application page over the network to the originator of the request. In paragraph 16 of the Office action it is asserted: “Von Rosen teaches this(Fig 6-9).” Figures 6-9 of von Rosen illustrate various windows produced by a WWW browser on a client computer browsing a WWW site of the von Rosen system. These windows relate to ordering personalized branded merchandise. None of these windows provide an application for a product or service. No decision regarding the buyer is required to approve any order of branded merchandise in the von Rosen system. Furthermore, there is no suggestion that the web pages for receiving an order for personalized branded merchandise would have any applicability to the home banking system of Lawlor relied upon to show an application module. To the contrary, as discussed above, Lawlor expressly teaches away from a system that uses a personal computer. Accordingly, the applied art teaches away from using web pages of von Rosen to conduct the home banking services of Lawlor.

For at least the reasons set forth with respect to claim 8 and 9 and the further specific reasons set forth above, Bowman-Amuah in view of Jawahar, von Rosen and Lawlor does not

show or suggest the steps of the invention defined by dependent claim 12. Accordingly, the recent Office action does not establish a *prima facie* case of obviousness against claim 12. Appellant respectfully requests that the rejection of claim 12 over Bowman-Amuah in view of Jawahar be reversed.

Claim 14

Claim 14 defines a method for dynamically creating an application form in a manner similar to claim 1. Claim 14 further sets forth that the request to apply for at least one of a plurality of products is in the form of a uniform resource locator, similar to the limitation of claim 7. Claim 14 also includes the step of parsing the uniform resource locator to identify the products. Claim 14 includes all the steps and limitations discussed above with respect to claim 1. Claim 14 is rejected for the same reasons as claim 1. Accordingly, Bowman-Amuah in view of Jawahar, von Rosen and Lawlor does not show the method of claim 14 for at least the reasons discussed above with respect to claims 1 and 7. Appellant respectfully requests the reversal of the rejection of claim 14 over Bowman-Amuah in view of Jawahar, von Rosen and Lawlor as these references fail to render claim 14 obvious for the same reasons as discussed above with respect to claims 1 and 7.

Claims 15-19 dependent from Claim 14

Claims 15-19 are identical to claims 2-6 but for depending from claim 14. Claims 15-19 are rejected for the same reasons as claims 2-6. Bowman-Amuah in view of Jawahar, von Rosen and Lawlor does not show or suggest the invention as defined by claims 15-19 for at least the reasons discussed above with respect to claim 14 and claims 2-6. Appellant respectfully requests that the rejections of claims 15-19 be reversed for the reasons set forth above.

Response to Arguments

Paragraph 18 of the Office action asserts that applicant's arguments with respect to claims 1-19 have been considered but are not persuasive. This statement is disingenuous. The Examiner has simply alternated issuing two rejections against this application. Appellant's arguments have been side stepped by this appearance of issuing a new rejection, when in fact appellant has previously fully replied to the Office action. Specifically, appellant has fully

responded to the recent Office action, as it is practically identical to the second Office action issued in January 2003. The recent Office action does not address appellant's arguments made in Response to the second Office action filed in April 2003.

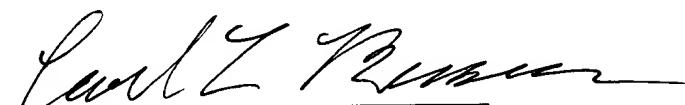
Conclusion

The claimed invention relates to the dynamic creation of an application form, that is a form for submitting information to apply for products and services. The applied prior art is silent regarding the creation of an application form. Accordingly, the applied prior art cannot suggest the invention set forth by the pending claims. Appellant has replied to every rejection set forth in the Office action in the above remarks. Each rejection has been shown deficient or overcome for the reasons set forth above. Accordingly, appellant submits that pending claims 1-19 are patentably distinguishable over the prior art of record. Appellant requests that the rejections be reversed, the application be returned to the Examiner and the claims allowed.

Respectfully submitted,

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## Appendix

### Claims Involved in Appeal

1. A method for dynamically creating a network based application form comprising the steps of:

receiving a request to apply for a plurality of products, the request received over a network, wherein specific information is required to be submitted to apply for each one of the plurality of products;

assembling an application page for display over the network, said page assembled from a plurality of documents, wherein each document of the plurality of documents contains at least one field corresponding to the specific information required to apply for one of the plurality of products; and

receiving information input corresponding to each field contained in the application page.

2. The method of claim 1, further including the steps of:

validating the information input by comparing the information input to validation criteria; and

when the information input fails to correctly compare to the validation criteria, assembling a second application page including prompts to reenter information and receiving corrected information input.

3. The method of claim 1, further including the step of forwarding the information input to a decision module for processing the information input.

4. The method of claim 1, further including the steps of:

determining whether the request to apply originates from a customer that is logged in to a session manager;

accessing stored data regarding the customer if the customer is logged in, wherein the step of assembling an application page includes inserting the stored data in the application page displayed over the network.

5. The method of claim 1 wherein the plurality of products includes banking products and the specific information required to apply for one of the plurality of products includes information regarding an amount of credit to be extended.
6. The method of claim 5 further including the step of forwarding the information input to a decision module for processing the information input to determine if data input justifies extension of credit.
7. The method of claim 1 wherein the request is in the form of parameters received within a universal resource locator.
8. A system for obtaining application data from an applicant through a dynamically created network based application form comprising:
  - a dynamic application module for receiving a request to apply for at least one of a plurality of products, dynamically creating an application requesting data required to apply for the at least one a plurality of products, and receiving the data requested; and
  - a decision module in communication with said dynamic application module, said decision module for receiving the data, generating a decision regarding the application, and providing the decision to said dynamic application module.
9. The system according to claim 8 further comprising:

a universal session manager in communication with said dynamic application module, said universal session manager for creating a verification of an originator of the request; and

a profile database in communication with said dynamic application module, said profile database for providing stored data regarding the originator of the request.

10. The system according to claim 9 further comprising a host server wherein said dynamic application module, said universal session manager and said database reside on said host server.
11. The system according to claim 10 wherein said host server is connected to a network.
12. The system according to claim 11 wherein said dynamic application module provides the application in the form of an application page over the network to the originator of the request.
13. The system according to claim 8 further including a processing database in communication with said dynamic application module, said processing database for receiving data regarding use of said dynamic application module.
14. A method for dynamically creating a network based application form comprising the steps of:

receiving, over a network, a request to apply for at least one of a plurality of products in the form of a uniform resource locator, wherein specific information is required to be submitted to apply for each one of the plurality of products;

parsing the uniform resource locator to identify the at least one of a plurality of products;

assembling an application page for display over the network, said page assembled from a plurality of documents, wherein each document of the plurality of

documents contains at least one field corresponding to the specific information required to apply for one of the plurality of products; and

receiving information input corresponding to each field contained in the application page.

15. The method of claim 14, further including the steps of:

validating the information input by comparing the information input to validation criteria; and

when the information input fails to correctly compare to the validation criteria, assembling a second application page including prompts to reenter information and receiving corrected information input.

16. The method of claim 14, further including the step of forwarding the information input to a decision module for processing the information input.

17. The method of claim 14, further including the steps of:

determining whether the request to apply originates from a customer that is logged in to a session manager;

accessing stored data regarding the customer if the customer is logged in, wherein the step of assembling an application page includes inserting the stored data in the application page displayed over the network.

18. The method of claim 14 wherein the plurality of products includes banking products and the specific information required to apply for one of the plurality of products includes information regarding an amount of credit to be extended.

19. The method of claim 18 further including the step of forwarding the information input to a decision module for processing the information input to determine if data input justifies extension of credit.